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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,968	10/09/2001	Joachim Noack	02565/93	8345
26646	7590	05/18/2005	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			THOMPSON, KATHRYN L	
			ART UNIT	PAPER NUMBER
			3763	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No.	Applicant(s)	
	09/973,968	NOACK, J	
	Examiner	Art Unit	
	Kathryn L. Thompson	3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peabody et al (5,643,201) in view of Veech (4,668,400). Peabody et al discloses a method for determining intraperitoneal volume during peritoneal dialysis comprising the steps of passing peritoneal solution from a peritoneal cavity, passing dialyzing fluid, measuring the concentration of an endogenous substance, determining the intraperitoneal volume from the variation in the concentration over time, and determining an ultrafiltration rate (Column 4, Line 8 – Column 6, Line 4; Entire reference). Veech discloses measuring the concentration of an endogenous substance such as albumin. It would have been obvious to one with ordinary skill in the art to use the teachings of Veech and modify the invention of Peabody et al since endogenous substances are notoriously well known in the art for being used in peritoneal dialysis.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simon et al (5,542,919) in view of Veech. Simon et al discloses a method for determining intraperitoneal volume during peritoneal dialysis comprising the steps of passing peritoneal solution from a peritoneal cavity, passing dialyzing fluid, measuring

the concentration of an endogenous substance, determining the intraperitoneal volume from the variation in the concentration over time, and determining an ultrafiltration rate (Column 2, Line 28 – Column 3, Line 16; Entire reference). Veech discloses measuring the concentration of an endogenous substance such as albumin. It would have been obvious to one with ordinary skill in the art to use the teachings of Veech and modify the invention of Simon et al since endogenous substances (albumin) are notoriously well known in the art for being used in peritoneal dialysis.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tysk et al (3,620,215) in view of Veech. Tysk et al discloses a method for determining intraperitoneal volume during peritoneal dialysis comprising the steps of passing peritoneal solution from a peritoneal cavity, passing dialyzing fluid, measuring the concentration of an endogenous substance, determining the intraperitoneal volume from the variation in the concentration over time, and determining an ultrafiltration rate (Entire reference). Veech discloses measuring the concentration of an endogenous substance such as albumin. It would have been obvious to one with ordinary skill in the art to use the teachings of Veech and modify the invention of Tysk et al et al since endogenous substances are notoriously well known in the art for being used in peritoneal dialysis.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over EPA 0,149,001 in view of Veech. EPA 0,149,001 discloses a method for determining intraperitoneal volume during peritoneal dialysis comprising the steps of passing peritoneal solution from a peritoneal cavity, passing dialyzing fluid, measuring the concentration of an endogenous substance, determining the intraperitoneal volume from

the variation in the concentration over time, and determining an ultrafiltration rate (Entire reference). Veech discloses measuring the concentration of an endogenous substance such as albumin. It would have been obvious to one with ordinary skill in the art to use the teachings of Veech and modify the invention of EPA 0,149,001 since endogenous substances are notoriously well known in the art for being used in peritoneal dialysis.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ash (US 6,409,699) in view of Veech. Ash discloses a method for determining intraperitoneal volume during peritoneal dialysis comprising the steps of passing peritoneal solution from a peritoneal cavity, passing dialyzing fluid, measuring the concentration of an endogenous substance, determining the intraperitoneal volume from the variation in the concentration over time, and determining an ultrafiltration rate (Column 6, Lines 1 – 56 Entire reference). Veech discloses measuring the concentration of an endogenous substance such as albumin. It would have been obvious to one with ordinary skill in the art to use the teachings of Veech and modify the invention of Peabody et al since endogenous substances are notoriously well known in the art for being used in peritoneal dialysis.

Response to Arguments

Applicant's arguments filed on January 26, 2005 have been fully considered but they are not persuasive. Applicant states that Veech does not disclose the measuring of the concentration of albumin in "the peritoneal solution in the peritoneal cavity."

Examiner would first like to point out to Applicant that the claim language does not recite

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the measuring of the concentration of albumin in the peritoneal solution. That is, the claim does not recite "where" or "in what" the albumin is measured from. The claim simply recites that the albumin "passes through a peritoneum into the peritoneal solution in the peritoneal cavity." Examiner interprets this language as a function of what the albumin does. There is no mention in the claims as to where the albumin is located when measured.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn L. Thompson whose telephone number is 703-305-3286. The examiner can normally be reached on 8:30 AM - 6:00 PM: 1st Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KLT



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TECHNOLOGY CENTER 3763